

### **Remarks**

This communication is considered fully responsive to the Office Action. Claims 1-9, 11-14, 16, 18-22, and 24-34 were examined. Claims 1-9, 11-14, 16, 18-22, and 24-34 stand rejected. Claims 16 and 24-30 are currently amended. No claims are currently being canceled. No new claims are currently being added. Reexamination and reconsideration of the pending claims are respectfully requested.

### **Examiner Interview**

Applicant appreciates the Examiner's invitation on page 4 of the Office Action to further discuss the issues related to the 112 and 101 rejections; and the telephone interview granted on May 27, 2010. During the telephone interview, the Examiner explained his reasoning for upholding the Section 112, first paragraph, rejection of claims 24-30 and stated that amending claim 24 to recite "a mobile device" and arguing that it is well-known in the art that a mobile device contains computer-readable medium may overcome the rejection.

Applicant also noted for the Examiner that the Section 112, second paragraph, should be withdrawn as the claims do include proper antecedent basis for "the subscribed services" in claims 1 and 16. The Examiner agreed.

Applicant also noted that there was no support in the Office Action for rejecting claim 31. The Examiner acknowledged that claim 31 was not called out separately in the Office Action, but stated that his reasoning would be the same as set forth for claim 1 on pages 6 and 9. Applicant also noticed after the Examiner interview that there was no

rejection of claim 32 in the Office Action. Applicant responds on the basis that the Examiner intended to rely on the same support mentioned above for claim 31.

Applicant respectfully requests the Examiner to contact the below-listed attorney prior to issuing another Office Action if there are any further issues that may be remedied by another telephone interview.

#### **First Claim Rejection - 35 U.S.C. 112**

The previous Office Action rejected claims 16 and 24-30 under 35 U.S.C. 112, first paragraph. The most recent Office Action rejects claim 24-30 and 34. Therefore, Applicant believes the rejection of claim 16 has been withdrawn. In addition, Applicant interprets the reasoning to support the rejection of claim 34 to be the same as that provided for claims 24-30, but notes that no additional reasoning was set forth in the most recent Office Action.

The Office Action states that computer-readable storage is not described in the specification in such a way as to reasonably convey that the inventor had possession of the claimed invention. Applicant respectfully disagrees.

Applicant previously cited to the specification at paragraph [0044] disclosing that the mobile handset may comprise, as an example, random access memory (RAM) 145. Clearly, RAM 145 is a well known computer-readable storage. Of course other types of computer-readable storage are also known in the mobile electronic device arts.

In Response to Arguments in the previous Office Action, the Examiner states that the statute is clear and requires “exact terms.” The most recent Office Action no longer

states this, but maintains the rejection. Applicant believes that although not stated, the Examiner is still making “exact terms” a requirement. This interpretation of the statute is incorrect. The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement, MPEP 2163. Therefore, Applicant maintains that the rejection is in error.

However, in order to expedite examination, Applicant has also made amendments to the claims in view of the Examiner Interview summarized above. Applicant further notes that it would have been well within the realm of someone having ordinary skill in the mobile devices arts at the time of the invention (the application was filed in 2004), to provide a mobile device with non-transitory computer-readable medium.

#### **Second Claim Rejection - 35 U.S.C. 101**

The Office Action rejected claims 24-30 under 35 U.S.C. 101 as being directed to non-statutory subject matter since the computer readable storage may be interpreted as transitory or non-transitory storage. Claim 24 has been amended to recite a non-transitory computer-readable storage.

#### **Third Claim Rejection - 35 U.S.C. 112**

The Office Action rejected claims 1 and 16 under 35 U.S.C. 112, second paragraph, because the recitation of “the subscribed services in line 8 and line 13, respectively, lacks sufficient antecedent basis. Applicant respectfully disagrees. Claim 1 recites in relevant part “. . . firmware and software for **subscribed services** into the

electronic device to enable use of **the subscribed services.**” Claim 16 recites in relevant part “. . . of the wireless communication device with **subscribed services** a user pre-selected if the wireless communication device has not already been provisioned in the network . . . updating one or both of firmware and software for **the subscribed service.**”

During the telephone interview summarized above, Applicant confirmed with the Examiner that the rejection was in error and therefore should be withdrawn.

#### **Fourth Claim Rejection - 35 U.S.C. 103(a)**

The Office Action rejected claims 1-9 and 31 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,615,038 to Moles, et al. (“Moles”) in view of U.S. Patent Publication No. 2004/0031029 to Lee (“Lee”) in view of U.S. Patent No. 6,029,065 to Shah (“Shah”) and U.S. Patent Publication No. 2003/0186695 to Bridges, et al. (“Bridges”). Applicant respectfully traverses this rejection.

Claim 1 recites “an electronic device having at least one of firmware and software, the electronic device being communicatively coupled to the device server and the customer care center, the electronic device notifying the customer care center to download at least one of firmware and software for subscribed services into the electronic device to enable use of the subscribed services . . . wherein one or more parameters specific to updating the at least one of firmware and software for the subscribed services in the electronic device are provisioned, during provisioning of a number assignment module (NAM) in the electronic device, by the network” (emphasis added). The Office

Action properly acknowledges on page 6 that Moles does not disclose the underlined portions of the claim.

Instead, the Office Action relies on Lee as disclosing one or more parameters specific to updating the at least one of firmware and software for the subscribed services in the electronic device are provisioned, during provisioning of a number assignment module (NAM) in the electronic device, by the network. Specifically, the Office Action cites to para. [0022], which states:

*[0022] The update schedule specifies the time when an update for a particular software component in a particular networked device should be performed. Optionally, the update schedule may also include a priority classification for the update. When the scheduled time arrives to update a particular software component on a particular networked device, a software update engine (which may include one or more individual sub-engines) sends the update parameters regarding the update file, along with any other parameters relevant to the update, to a local update agent local to the particular networked device on which the software component to be updated is located. The information sent includes, for example, parameters indicating where in the network or on the Internet the actual update file may be found and downloaded.*

The update schedule in Lee resides with the administrator console (see para. [0021] in Lee) and not in the electronic device. In addition, there is no disclosure in Lee that one or more parameters specific to updating the firmware and software are provisioned during provisioning of a NAM in the electronic device.

Then the Office Action relies on Shah as disclosing notifying the customer care center to download at least one of firmware and software for subscribed services into the electronic device to enable use of the subscribed services. Specifically, the Office Action cites to col. 10, lines 46-53, which states:

*In this embodiment, information regarding local feature code values is provided only when access to a feature is requested by the mobile user. Because the downloading of the feature code information is triggered by the request for access to a feature, the mobile user need not perform any additional steps beyond that to which he or she is already accustomed, with the conversion occurring internally within the mobile station's processor.*

Shah discloses providing local feature code values when a feature is requested by the mobile user. Feature code values in the visited network are explained in Shah at col. 10, lines 1-25, which states in part:

*For mobile station handsets which do not have menu display capability, features are typically selected by a pressing a keystroke sequence designated by the mobile's home network. For example, if "\*66#" (+ "Send") is designated by the home network service provider for activating Call Waiting, and "\*67#" (+ "Send") for deactivating Call Waiting, the mobile user will press the four keys in the proper sequence. To continue the example, the visited network's feature codes for Call Waiting are "\*55#" and "\*56#" for activation and deactivation, respectively. Following the downloading of the correct system parameters, including the system-specific feature codes of the visited network, the mobile station's processor will cause the mobile station to transmit a "\*55#", even when the user has pressed "\*66#".*

Clearly, providing code values (e.g., \*55 for the visited network corresponding to \*66 in the home network) is not the same as notifying the customer care center to download firmware and software for subscribed services.

The Office Action also cites to col. 8, lines 5-48, but this is just further disclosure along the same lines as already discussed above.

For at least the foregoing reasons claim 1 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2-9 depend from claim 1, which is believed to be allowable. Therefore, claims 2-9 are also believed to be allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claims 2-9 is respectfully requested.

As noted in the Examiner Interview summary, above, a separate rejection of claim 31 was not set forth in the Office Action. However, claim 31 depends from claim 1 and therefore is also believed to be allowable for the same reasons as claim 1. Applicant also believes claim 31 is allowable for the same reasons discussed below for claim 16. Applicant respectfully requests that if the rejection of claim 31 is maintained in a subsequent Office Action, that the rejection of claim 31 be specifically called out and supported.

#### **Fifth Claim Rejection - 35 U.S.C. 103(a)**

The Office Action rejected claims 11-14 under 35 U.S.C. 103(a) as being unpatentable over Moles in view of Shah and Bridges. Applicant respectfully traverses this rejection.

Claim 11 recites “an electronic device configured to notify a customer care center to download at least one of firmware and software for subscribed services into the electronic device to enable use of the subscribed services.” The Office Action again relies on Shah. As already discussed above for claim 1, Shah does not provide support for these recitations. Therefore, claim 11 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 11.

Claims 12-14 depend from claim 11, which is believed to be allowable. Therefore, claims 12-14 are also believed to be allowable for at least the same reasons as claim 11. Withdrawal of the rejection of claims 12-14 is respectfully requested.

As noted in the Examiner Interview summary, above, a separate rejection of claim 32 was not set forth in the Office Action. However, claim 32 depends from claim 11 and therefore is also believed to be allowable for the same reasons as claim 11. Applicant also believes claim 32 is allowable for the same reasons discussed below for claim 16. Applicant respectfully requests that if the rejection of claim 32 is maintained in a subsequent Office Action, that the rejection of claim 32 be specifically called out and supported.

#### **Sixth Claim Rejection - 35 U.S.C. 103(a)**

The Office Action rejected claims 16, 18-22, and 33 under 35 U.S.C. 103(a) as being unpatentable over Moles in view of U.S. Patent Publication No. 2002/0028673 to Chang, et al. ("Chang") and further in view of Shah. Applicant respectfully traverses this rejection.

The Office Action relies on Shah at col. 3, lines 25-47, but states on page 26 of the Office Action that "Applicants are invited to provide a [sic] new language related to the amended portion of claim 16 for clarity." Shah discloses that once a visiting mobile station is registered, the base station downloads information to the mobile station notifying the mobile station of which network features are available and how they may be accessed in the local network. Therefore, Applicant has amended claim 16 to clarify



“recognizing when the wireless communication device is new to the wireless network and initiating provisioning of the wireless communication device, with subscribed services a user pre-selected when signing up for a network service, if the wireless communication device has not already been provisioned in the wireless\_network.” Support for this amendment is found in the specification as originally filed, e.g., at para. [0068]-[0071]. Shah does not teach at least these recitations. Therefore, claim 16 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 16.

Although Applicant believes that the claim amendments sufficiently distinguish over the teachings in Shah, **Applicant respectfully invites the Examiner to telephone the below-listed attorney before issuing another Office Action if further amendment is still believed necessary in this regard in order to put claim 16 in condition for allowance.**

Claims 18-22 and 33 depend from claim 16, which is believed to be allowable. Therefore, claims 18-22 and 33 are also believed to be allowable for at least the same reasons as claim 16. Withdrawal of the rejection of claims 18-22 and 33 is respectfully requested.

In addition, the further recitations of claim 33 are also believed to be allowable for the reasons already discussed above for claim 1.

**Seventh Claim Rejection - 35 U.S.C. 103(a)**

The Office Action rejected claims 24-30 and 34 under 35 U.S.C. 103(a) as being unpatentable over Moles in view of Shah and Chang. Applicant respectfully traverses this rejection.

Claim 24 recites “sending a message over the wireless network to a device server for recognizing by the device server when the electronic device is new to the wireless network so that the device server initiates provisioning of the electronic device with subscribed services a user pre-selected if the electronic device has not already been provisioned in the network.” At least these recitations are not taught or suggested, as already discussed above for claim 16.

Claims 25-30 and 34 depend from claim 24, which is believed to be allowable. Therefore, claims 25-30 and 34 are also believed to be allowable for at least the same reasons as claim 24. Withdrawal of the rejection of claims 25-30 and 34 is respectfully requested.

In addition, the further recitations of claim 34 are also believed to be allowable for the reasons already discussed above for claim 1.

### Conclusion

Applicant respectfully requests the Examiner to telephone the below-listed attorney if further amendment is still believed to be necessary in order to put the claims in condition for allowance. Otherwise, Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

/Mark D. Trenner/

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By: \_\_\_\_\_

Mark D. Trenner  
Reg. No. 43,961  
(720) 221-3708